The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte KOSHIRO SHIMAZU, YOSHIAKI TATENO, MITSUI MAZARA, NAOKI OKAMOTO, TAKA OSHIMA, MINORU NAGASAWA and HIDEKI NAKAMURA

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Appeal No. 2004-2018
Application No. 09/197,499

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ON BRIEF

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Before KIMLIN, WARREN and TIMM, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 18 and 20. Claims 11-17 stand withdrawn from consideration as being directed to a non-elected invention. Claim 1 is illustrative:

1. A powder Raney catalyst obtained by

(i) melting nickel and aluminum,

(ii) quenching droplets of said melted mixture by means of dropping them onto chilled water through a nozzle to obtain a quenched lump alloy,

(iii) optionally breaking the quenched lump alloy,

(iv) classifying and activating the alloy of step (ii) or (iii),

(v) using said alloy of step (iv) as a Raney catalyst in a hydrogenation reaction,

(vi) collecting said alloy of step (v),

(vii) crushing said Raney catalyst used in the hydrogenation reaction into powder, and

(viii) reactivating.

In the rejection of the appealed claims, the examiner relies upon the following references:

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|---|---|---|
| Raney | 1,628,190 | May 10, 1927 |
| Schuetz et al. (Schuetz) | 5,536,694 | Jul. 16, 1996 |

Appellants' claimed invention is directed to a powder Raney catalyst comprising an alloy of nickel and aluminum that is obtained by the recited process. The process includes crushing the Raney catalyst that is used in a hydrogenation reaction into a powder, and reactivating such powder. According to appellants, "used lump form Raney catalyst can be reused as raw material for powder type Raney catalyst whether the catalytic activity of the used lump form catalyst remains or not" (page 11 of Brief, last paragraph). Appellants further explain that "the thus obtained powder type Raney catalyst is available with as high catalytic activity as the conventional Raney catalyst has, even though the

powder type catalyst has been obtained from the used catalyst" (id.).

Appealed claims 1 and 20 stand rejected under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being unpatentable over Schuetz. Claims 1, 18 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schuetz in view of Raney.

Appellants submit at page 6 of the Brief that "the presently appealed claims 1, 18 and 20 should each be considered to stand and fall separately." However, the ARGUMENT section of appellants' Brief fails to set forth an argument that is reasonably specific to any of the three claims on appeal. Accordingly, the groups of claims separately rejected by the examiner stand or fall together with claim 1, and we will limit our consideration to the examiner's rejections of claim 1.

We have thoroughly reviewed each of appellants' arguments for patentability. However, we are in complete agreement with the examiner that the claimed subject matter is unpatentable over the cited prior art. Accordingly, we will adopt the examiner's reasoning as our own in sustaining the rejections of record, and we add the following for emphasis only.

The claims on appeal are drafted in product-by-process format and, therefore, certain legal principles apply. Although all claim recitations must be given consideration, it is the patentability of the claimed product that must be determined under 35 U.S.C. §§ 102 and 103. When the claimed product reasonably appears to be essentially the same as the product of the prior art that is made by a process different than the applicant's process, the burden is properly upon the applicant to prove with objective evidence that the claimed product is, in fact, patentably distinct from the prior art product. See In re Fessmann, 489 F.2d 742, 745, 180 USPQ 324, 326 (CCPA 1974); In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972).

In the present case, there is no dispute that Schuetz evidences that it was known in the art to employ nickel/aluminum Raney catalysts in powder form in hydrogenation reactions (see Schuetz at column 1, lines 30-50). Also, the examiner correctly points out that the known powder Raney catalysts are made by a process comprising the recited steps of melting nickel and aluminum, quenching droplets of the melted mixture, breaking or milling the quenched alloy, and activating the alloy before use in a hydrogenation reaction. The only step not expressly described in the prior art is crushing and reactivating the used

catalyst. However, based upon the sameness in composition and physical form between the claimed and prior art powder catalyst, and the similar manner in preparing the powder catalyst, we concur with the examiner that the burden is properly upon appellants to demonstrate with objective evidence that there is a patentable distinction between the powder Raney catalysts within the scope of appealed claim 1 and the powder Raney catalyst of the prior art. This appellants have not done.

Appellants advance no argument, let alone objective evidence, to the effect that there is an actual difference between the claimed powder catalyst and the powder catalyst of the prior art. Indeed, by stating that "the thus obtained powder type Raney catalyst is available with as high catalytic activity as the conventional Raney catalyst has" (page 11 of Brief, last sentence), appellants seem to acknowledge that there is no real distinction between the claimed and prior art Raney catalyst. By focusing on the argument that "the cited references, in any combination, fail to teach or suggest taking a lump form catalyst which has been used in a hydrogenation reaction, crushing it to a powder and reactivating the powder catalyst, as presently claimed" (sentence bridging pages 8 and 9 of Brief), appellants fail to address the thrust of the examiner's rejections. The

rejections are predicated upon the fact that the appealed claims define a product, namely, a powder Raney catalyst, and not the process of making the product. Significantly, appellants have failed to explain how the claimed product, made by the recited steps, is in any way different than the powder Raney catalyst of the prior art.

In conclusion, based on the foregoing and the reasons well-stated by the examiner, the examiner's decision rejecting the appealed claims is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

EDWARD C. KIMLIN )
Administrative Patent Judge )
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CHARLES F. WARREN ) BOARD OF PATENT
Administrative Patent Judge ) APPEALS AND
) INTERFERENCES
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CATHERINE TIMM )
Administrative Patent Judge )

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